

Remarks

Claims 1, 6, 8, 19 and 20 were pending. Applicants have canceled claims 1, 6, 8 and 19 without prejudice to Applicants' right to pursue their subject matter in the present application and in related applications.

Applicants have amended claim 20 to delete unnecessary words and to insert the text "with lupus" and "(SEQ ID NO:15) mRNA." Support for the amendment to claim 20 is found in the original application at least, for example, in paragraph [0077], in Table 1, and in original claim 20. Applicants submit that the amendment introduces no new matter into the application.

Upon entry of the present amendment, claim 20 will be pending and presented for consideration.

Election/Restrictions

The Office action stated that the claims included subject matter drawn to a nonelected invention, as the claims included methods for detecting SFRP1 proteins.

Applicants have canceled all pending claims except claim 20, which has been amended to recite comparing expression of SFRP1 (SEQ ID NO:15) mRNA. Accordingly, as amended, the claims are drawn to the elected invention.

Enablement rejections under 35 U.S.C. § 112

The Office action rejected claims 1, 6, 8, 19 and 20 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. The Office action acknowledged that the specification enables methods comprising contacting an LN-affected or LN-predisposed mouse kidney cell or mouse with a test agent; determining the level of SFRP1 (SEQ ID NO:15) mRNA in said kidney cell or in a kidney cell of said mouse; comparing the level of SFRP1 (SEQ ID NO:15) mRNA in said kidney cell or in said kidney cell of said mouse after said contacting to the level of SFRP1 (SEQ ID NO:15) mRNA prior to said contacting; and determining that said agent modulates mRNA expression in said kidney cell or said kidney cell

of said mouse if there is a decrease in the level of SFRP1 (SEQ ID NO:15) mRNA after said contacting step as compared to prior to said contacting step. The Office action nevertheless argues that the claims do not bear a reasonable correlation to the scope of enablement, alleging specifically, with respect to claims 19 and 20, that the claims are not limited to specific mouse and human SFRP1 genes, and that the disclosure in the specification and in the prior art “is not representative of the broadly claimed genus of SFRP1 nucleic acids” (Office action, page 16).

Applicants disagree with the rejection. Nevertheless, to advance prosecution, Applicants have canceled claims 1, 6, 8 and 19 without prejudice to Applicants right to pursue their subject matter in this application and in other applications. Similarly, Applicants have amended claim 20 to recite specifically “SFRP1 (SEQ ID NO:15) mRNA.” Applicants believe that the amendments to claim 20 address the concerns expressed in the Office action. Amended claim 20 complies with the enablement requirement, as one of ordinary skill in the art can compare expression of SFRP1 (SEQ ID NO:15) mRNA in mouse kidney samples without undue experimentation.

Applicants therefore respectfully request reconsideration and withdrawal of the rejections.

Written description rejections under 35 U.S.C. § 112

The Office action similarly rejected claims 1, 6, 8, 19 and 20 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. The Office action again argued that the specification did not convey that Applicants were in possession of a genus of SFRP1 genes.

Applicants disagree but, to advance prosecution, have canceled claims 1, 6, 8, and 19 and have amended claim 20 to recite SFRP1 (SEQ ID NO:15) mRNA. Applicants believe the amendment directly addresses the concern raised in the Office action and that the specification unambiguously provides a written description of the claimed invention involving comparing expression of SFRP1 (SEQ ID NO:15) mRNA in mouse kidney samples.

Applicants therefore respectfully request reconsideration and withdrawal of the rejections.

Rejections under the second paragraph of 35 U.S.C. § 112

The Office action rejected claims 19 and 20 under the second paragraph of 35 U.S.C. § 112 as allegedly indefinite over the recitations of “lupus-affected” and “lupus-predisposed.” Applicants continue to disagree that one of ordinary skill in the art would, for example, fail to understand that a lupus-affected mouse has lupus and that a lupus-predisposed mouse is predisposed to lupus. Nevertheless, to advance prosecution, applicants have canceled claim 19 without prejudice and have amended claim 20 to remove the recitations of “lupus-affected” and of “lupus-predisposed.” Applicants therefore respectfully request reconsideration and withdrawal of the rejections.

CONCLUSION

Upon entry of the present amendment, claim 20 will be pending and presented for consideration. Examiner Myers is encouraged to telephone the undersigned attorney to discuss any remaining issues.

Respectfully submitted,

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Reg. No. 48,645

Tel. No.: (617) 261-3169
Fax No.: (617) 261-3175



Brian Fairchild, Ph.D.
Attorney for Applicants
Kirkpatrick & Lockhart Nicholson
Graham LLP
State Street Financial Center
One Lincoln Street
Boston, Massachusetts 02111-2950